

REMARKS

Favorable reconsideration and allowance of the present application are respectfully requested in view of the following remarks. Claims 1-33 were pending prior to the Final Office Action. In this Reply, claims 4, 11 and 18 are canceled and the features therein are incorporated into independent claims 1, 7 and 12 respectively. Accordingly, no new issues are presented. Claims 1-3, 5-10, 12-17 and 20-33 are pending. Claims 1, 7, 12, 20 and 27 are independent.

§ 103 REJECTION – MAO, KAPLAN

In the Office Action, the Examiner rejected claims 1-3, 6, 12 and 14-17 under 35 U.S.C. § 102(e) as allegedly being anticipated by Mao et al. (U.S. Publication 2003/0115612). *See Final Office Action, item 2.* Also, claim 13 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Mao. *See Final Office Action, item 4.* Further, claims 4, 5, 18, 19, 20, 22-27 and 29-33 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Mao in view of Kaplan (USP 6,058,430). *See Final Office Action, item 3.* As noted above, claims 4 and 18 are canceled and the features therein are incorporated into independent claims 1 and 12, respectively. Therefore, applicants will treat claims 1-3, 5-6, 12-17, 19-20, 22-27 and 29-33

as allegedly being unpatentable over Mao in view of Kaplan. Applicants respectfully traverse.

Independent claim 1 recites, in part “wherein, in the performing step, when user-desired data contents are selected by means of a browser for controlling data contents, the current channel is tuned in to a new channel corresponding to the selected data contents.” In the Final Office Action, the Examiner admits that Mao fails to teach or suggest the above recited feature. *See Final Office Action, page 11.* However, the Examiner alleges that Kaplan discloses such a feature and also alleges that it would have been obvious to modify Mao with the ability to change the channel tuned by selecting different data content. This allegation fails.

A requirement to establish *prima facie* case of obviousness is that there must be a suggestion or motivation within the cited references to modify the references as the Examiner proposes in the Office Action. *See M.P.E.P. 2143.01.* The cited reference must be considered in its entirety. *See M.P.E.P. 2141.02.* If the proposed modification renders the cited reference unsatisfactory for its intended purpose, then by definition, there is no suggestion or motivation to make the proposed modification. *See M.P.E.P. 2143.01.* Thus, if the proposed modification renders the cited reference unsatisfactory for its intended purpose, the rejection fails.

In this instance, when Kaplan is considered in its entirety as required, modifying Mao as the Examiner suggests renders Mao unsatisfactory for its intended purpose. More specifically, Mao describes that Internet connectivity requiring two-way data paths is undesirable. In paragraph [0014], Mao states “It would be desirable to implement interactive Internet access on a **one way CATV network without a telephone connection.**” *Emphasis added.* Even if the viewer is already connected to the Internet via two-way CATV or telephone return, Mao still describes this as a problem since there may still be an unacceptably long wait for a selected Web page to appear. In paragraph [0016], Mao states that, “it would be desirable to implement interactive Internet access with a quick response time, **not requiring establishment of Internet access, Internet connection and subsequent downloading from the remote web site.**” *Emphasis added.* In other words, Mao specifically teaches that a separate Internet access connection is undesirable.

However, Kaplan specifically discloses that the network interface for Internet connection and the connection for the TV signal reception are separate. *See Figure 1.* Kaplan states “In a preferred embodiment ... the connection to the Internet is via a telephone line which plugs into the network interface (42).” *See col. 5, lines 38-43.* Thus, even assuming *arguendo* that Kaplan teaches tuning to a channel based upon changing the data contents as alleged by the

Examiner, Kaplan does so through connecting through the Internet separately from the video signal provided to the TV.

This is in complete contrast with the stated desires of Mao. Accordingly, if Mao is modified with the teachings of Kaplan as the Examiner suggests, Mao would be rendered unsatisfactory for its intended purpose. Then by definition, Mao and Kaplan cannot be combined in any rejection based upon the combination of Mao and Kaplan cannot stand.

It should be further noted that Kaplan teaches away from Mao. This is another indication that Mao and Kaplan cannot be combined.

Independent claim 12 recites, in part "wherein, when the user selects data contents by means of a forward/backward function of the browser, the A/V data interface control unit checks whether or not the currently displayed channel corresponds to the selected data contents according to the integrated information, and, if the channel does not correspond to the selected contents, the A/V data interface control unit controls the inverse multiplexing unit to tune in to the channel corresponding to the selected data contents."

Again, the Examiner admits that the above recited feature is not taught or suggested in Mao but alleges that Kaplan teaches the feature and it would be obvious to modify Mao with the teachings of Kaplan. However, as demonstrated above, Mao and Kaplan cannot be properly combined.

Accordingly, claim 12 is distinguishable over the combination of Mao and Kaplan.

Independent claim 20 recites, in part “upon receipt of a data content change request, ... changing the channel to correspond to the requested data content change if it is determined that the current channel does not correspond to the requested data content change.” As demonstrated above, Mao and Kaplan cannot be combined to teach or suggest this feature. Accordingly, independent claim 20 is distinguishable over the combination of Mao and Kaplan.

Independent claim 27 recites, “upon receipt of a data content change request ... changing the channel to correspond to the requested data content change if it is determined that the current channel does not correspond to the requested data content change.” As demonstrated above, and in contrast with the Examiner’s allegation, Mao and Kaplan cannot be combined to teach or suggest this feature. Accordingly, independent claim 27 is distinguishable over Mao and Kaplan.

Claims 2-3, 5-6, 13-17, 19, 22-26 and 29-33 depend from independent claims 1, 12, 20 and 27 directly or indirectly. Accordingly, for at least due to the dependencies thereon, these dependent claims are also distinguishable over Mao and Kaplan.

Applicants note that claims 19, 23, and 13 are rejected in combination with Official Notices regarding the features of these claims. Applicants respectfully challenge the Official Notices taken and request that valid prior art reference(s) be cited in support of the Examiner's position.

Applicants respectfully request that the rejection of claims 1-3, 5-6, 12-17, 19-20, 22-27 and 29-33 based on Mao and Kaplan be withdrawn.

§ 103 REJECTION – MAO, SHOFF

In the Final Office Action, the Examiner rejects claims 7-8 under 35 U.S.C. § 102(e) as allegedly being anticipated by Mao. *See Final Office Action, item 2.* The Examiner also rejects claims 9 and 10 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Mao. *See Final Office Action, item 4.* Further, the Examiner rejects claim 11 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Mao in view of Shoff et al. (USP 6,240,555). As indicated above, claim 11 is canceled and the features therein are incorporated into independent claim 7. Therefore, applicants will treat claims 7-10 as allegedly being unpatentable over Mao in view of Shoff. Applicants respectfully traverse.

Independent claim 7 recites, in part "wherein if a browser function is not operated, only the A/V signal is displayed." The Examiner admits that Mao does not teach or suggest this feature. *See Final Office Action, page 20.* The Examiner attempts to correct this deficiency of Mao through the teachings of

Shoff. More specifically, the Examiner alleges that Shoff discloses displaying only the A/V signal when there is no supplemental information and relies upon on col. 9, lines 1-7 of Shoff. Even assuming *arguendo* that the Examiner's assertion is true regarding Shoff, Shoff still does not teach or suggest the above recited feature.

In claim 7, displaying only the A/V signal is conditioned upon the browser function not being operated. In contrast, in Shoff, simply displaying the video data stream is conditioned upon there being no supplemental content. The absence of supplemental content is not equivalent to the browser function not being operated.

The Examiner attempts to account for this deficiency by alleging that when there is no supplemental information, the browser is not operated. In other words, the Examiner appears to be alleging that the only time the browser is not operated is when there is no supplemental information. To state it another way, the Examiner is alleging inherency.

M.P.E.P. is clear that the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *See M.P.E.P. 2112*. In this instance, a lack of supplemental information may result in the browser function not being operated. However, the browser function also may not be operated for a variety of other reasons such as the user simply choosing not to operate the browser

function. Because the feature does not necessary flow from the teaching of Shoff, the inherency argument fails.

Clearly, independent claim 11 is distinguishable over Mao and Shoff. Claims 8-10 depend from independent claim 7 directly or indirectly. Accordingly, these dependent claims are also distinguishable over Mao and Shoff.

In addition, applicants respectfully challenge the Official Notices taken in rejecting claims 9 and 10, and request that proper prior art be cited in support.

For at least the reasons stated above, applicants respectfully request that the rejection of claims 7-10 based on Mao and Shoff be withdrawn.

§ 103 REJECTION – MAO, KAPLAN, SHOFF

Claims 21 and 28 stand rejected under 35 USC 103(a) as allegedly being unpatentable over Mao in view of Kaplan and Shoff. Applicants respectfully traverse.

Claims 21 and 28 depend from independent claims 20 and 27, respectively. It is demonstrated above that claims 20 and 27 are distinguishable over Mao and Kaplan. Shoff is not relied upon to correct for at least the above noted deficiencies of Mao and Kaplan. Accordingly, claims 20 and 27 as well as claims 21 and 28 are distinguishable over Mao, Kaplan and Shoff.

Also, Mao and Kaplan cannot be combined as demonstrated above. Further, claim 21 and 28 recite, in part "if a browser unit is not operating, displaying the A/V signals of the selected channel only." As demonstrated above, Shoff cannot teach or suggest this feature.

For at least the reasons stated above, claims 21 and 28 are distinguishable over the combination of Mao, Kaplan and Shoff. Applicants respectfully request that the rejection of claims 21 and 28 based on Mao, Kaplan and Shoff be withdrawn.

CONCLUSION

All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact Hyung Sohn (Reg. No. 44,346), to conduct an interview in an effort to expedite prosecution in connection with the present application.

Pursuant to the provisions of 37 C.F.R. § 1.17 and 1.136(a), the Applicants hereby petition for an extension of one (1) month to October 2, 2006 in which to file a reply to the Office Action. The required fee of \$ 120.00 is enclosed herewith.

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Reply to Office Action of June 2, 2006

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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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BIRCH, STEWART, KOLASCH &, BIRCH, LLP

By: Esther Chong
Esther H. Chong
Reg. No. 40,953
P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

HNS
EHC/HNS/jen
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